

Appl. No. : 10/635,773

Amendment Dated Nov. 21, 2005

Response to Office Action Mailed October 5, 2005

FILED VIA FAX: (571) 273-8300

REMARKS**A. GENERALLY**

Claims 1-57 remain in this application. Applicant wishes to thank the examiner for extending the courtesy of an interview on November 17, 2005. As noted in the Interview Summary prepared by the examiner, agreement was reached at that time that the claims would be in allowable condition if amended to further point out the personalized customization of the booklet component for a targeted recipient. In this regard, claims 1, 5, 6, 9, 13, 16, 20, 23, 28, 30, 33, and 35-57 have been amended.

B. CLAIM REJECTIONS

Claim Rejections under 35 U.S.C. 102(e)

1. Claims 1-57 as originally filed have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application 2001/0056463 filed by Grady (herein, "Grady").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP §2131, 8th Ed. (Rev. 3, 2005).)

Grady, according to its inventors, is a document management system and method and does not result in printing a custom document selected for a particular recipient. Further, Grady is directed to managing documents in electronic form. Inherent in the Grady management system is that the documents are present as true copies of an original document. Thus, each member of the audience that accesses an electronic "Grady" document will receive the same version of the document associated with a code. A Grady document is not, therefore, customized nor is its specific content selected for a particular recipient.

The present application is directed to systems and methods for incorporating personalized pages into a printed booklet. The printed booklets of the present invention comprise content selected/customized for a specific recipient. Grady teaches away from the production of paper documents and does not teach selecting content for a specific recipient thereby creating a customized document. While Grady suggests that e-mail notification messages may be customized according to meta information associated with the publication or the subject matter

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of the publication to which the link relates (Grady ¶ [0078]), this customization function is not directed to the documents represented by the links sent to the recipient by the e-mail, but rather are directed to the e-mail itself.

Based on the foregoing, Applicant submits that claim 1 of the present invention as examined is not anticipated by Grady. As previously noted, claim 1 has been amended to further point out the personalized selection of content for a specific recipient. Applicant further submits that claim 1 (as amended) is not anticipated by Grady and is thus allowable over the cited prior art.

The examiner also rejected independent claims 9, 16, 23, 35, 37, 39 and 46 (as examined) using the same rationale as proffered in the rejection of claim 1 (as examined). Applicant submits that independent claims 9, 16, 23, 35, 37, 39 and 46 (as examined) are allowable over Grady for the same reasons presented by Applicant in support of allowance of claim 1 (as examined).

As previously noted, independent claims 9, 16, 23, 35, 37, 39 and 46 have been amended to further point out the personalized customization of the booklet component for the targeted recipient. Applicant further submits that independent claims 9, 16, 23, 35, 37, 39 and 46 (as amended) are not anticipated by Grady and are thus allowable over the cited prior art.

Dependent claims 2, 3, 4, 5 (as amended), 6 (as amended), 7 and 8 depend directly or indirectly from independent claim 1 (as amended) and thus recite all of the limitations of independent claim 1 (as amended). Dependent claims 2, 3, 4, 5 (as amended), 6 (as amended), 7 and 8 thus recite limitations not taught or disclosed by Grady and are not anticipated by Grady.

Dependent claims 10, 11, 12, 13 (as amended), 14, and 15 depend directly or indirectly from independent claim 9 (as amended) and thus recite all of the limitations of independent claim 9 (as amended). Dependent claims 10, 11, 12, 13 (as amended), 14, and 15 thus recite limitations not taught or disclosed by Grady and are not anticipated by Grady.

Dependent claims 17, 18, 19, 20 (as amended), 21, and 22 depend directly or indirectly from independent claim 16 (as amended) and thus recite all of the limitations of independent claim 16 (as amended). Dependent claims 17, 18, 19, 20 (as amended), 21, and 22 thus recite limitations not taught or disclosed by Grady and are not anticipated by Grady.

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Dependent claims 24-27, 28 (as amended), 29, 30 (as amended), and 31-34 depend directly or indirectly from independent claim 23 (as amended) and thus recite all of the limitations of independent claim 23 (as amended). Dependent claims 24-27, 28 (as amended), 29, 30 (as amended), and 31-34 thus recite limitations not taught or disclosed by Grady and are not anticipated by Grady.

Dependent claim 36 (as amended) depends from independent claim 35 (as amended) and thus recites all of the limitations of independent claim 35 (as amended). Dependent claim 36 (as amended) thus recites limitations not taught or disclosed by Grady and are not anticipated by Grady.

Dependent claim 38 (as amended) depends from independent claim 37 (as amended) and thus recites all of the limitations of independent claim 37 (as amended). Dependent claim 38 (as amended) thus recites limitations not taught or disclosed by Grady and are not anticipated by Grady.

Dependent claims 40 (as amended), 41 (as amended), 42 (as amended), 43 (as amended), 44 (as amended), and 45 (as amended) depend directly or indirectly from independent claim 39 (as amended) and thus recite all of the limitations of independent claim 39 (as amended). Dependent claims 40 (as amended), 41 (as amended), 42 (as amended), 43 (as amended), 44 (as amended), and 45 (as amended) thus recite limitations not taught or disclosed by Grady and are not anticipated by Grady.

Dependent claims 47 (as amended), 48 (as amended), 49 (as amended), 50 (as amended), 51 (as amended), 52 (as amended), 53 (as amended), 54 (as amended), 55 (as amended), 56 (as amended), and 57 (as amended) depend directly or indirectly from independent claim 46 (as amended) and thus recite all of the limitations of independent claim 46 (as amended). Dependent claims 47 (as amended), 48 (as amended), 49 (as amended), 50 (as amended), 51 (as amended), 52 (as amended), 53 (as amended), 54 (as amended), 55 (as amended), 56 (as amended), and 57 (as amended) thus recite limitations not taught or disclosed by Grady and are not anticipated by Grady.

C. CONCLUSION

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. For the above reasons, Applicant respectfully submits

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that the application is in condition for allowance with claims 1-57. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, Applicant respectfully requests an interview with the examiner and the examiner's supervisor prior to any new office action relating to the present Application. Attorney for the Applicant may be reached at the number listed below. The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully Submitted,



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